

REMARKS

By this amendment, Claims 19, 23 and 26 are cancelled, Claims 8, 11, 16, 20-22, 24 and 25 are amended, and claims 27-30 are added. Hence, Claims 8-11, 16-18, 20-22, 24, 25 and 27-30 are pending in the application.

ISSUES RELATING TO PRIOR ART

Claims 8-11 and 16-26 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Smith et al. ("*Smith*"; U.S. Patent No. 6,253,210), in view of Anuff et al. ("*Anuff*"; U.S. Patent No. 6,327,628).

INDEPENDENT CLAIMS 8, 16 and 21

The Office Action alleged that *Anuff* teaches creating an access and navigation script based on requests and responses that are generated during a session of navigating the network resource. *Anuff* describes a tool for constructing a customizable user interface for access to computer networks (i.e., a portal) which, based on the description, is a composite web page that provides an entry point to multiple resource windows, or modules (e.g., FIG. 2).

It is noteworthy that *Anuff* states that "script writers can change pages, and programmers can extend functionality through additional classes" (col. 2, lines 18-20). The foregoing statement does not describe a script that is automatically created based on a navigation session with a network resource. In contrast, *Anuff* discloses use of scripts written by script writers, presumably referring to human script writers. Thus, *Anuff* does not teach or suggest automatic generation of an access and navigation script as described in the application and recited in Claim 8. Furthermore, *Anuff* does not teach or suggest automatic creation of such a script based on requests and responses from a navigation session with a network resource. For example, the

specification describes an example in which a navigation session is performed by a network administrator.

Because *Anuff* does not fairly teach or suggest these features of Claim 8, *Anuff* does not support a prima facie obviousness rejection of Claim 8. Because *Smith* does not cure these deficiencies of *Anuff*, Claim 8 is patentable over *Smith* in view of *Anuff*.

In addition, the Office Action alleged that *Smith* teaches merging contemporaneous information that is specific to a client request into a request template to create a context-specific request. The *Smith* teachings of correlation of template data with subject data, i.e., deformation of the template to fit subject data, clearly describes a geometric deformation of image data. For example, col. 4, lines 3-15 states that “landmarks include data representing points, lines, surfaces, volumes, or other defining features in image data” and “deformation is the process of mapping one image to another image where both images represent the same structure but have different geometric proportions and orientations”, such as “bending, stretching, and rotating template data to match subject data.” The geometric deformations described in *Smith* would not teach or suggest to one skilled in the art the merging of contemporaneous information from a client request for use of a network resource into a generalized script for controlling use of the network resource.

Because *Smith* does not fairly teach or suggest these features of Claim 8, *Smith* does not support a prima facie obviousness rejection of Claim 8. Because *Anuff* does not cure these deficiencies of *Smith*, Claim 8 is patentable over *Smith* in view of *Anuff*.

However, to expedite prosecution, Claim 8 is amended to more thoroughly describe the manner in which the access and navigation script and the generalized script are created. These

amendments are not made for reasons of patentability, and are tangential to any equivalents of the amended claimed features.

(I) **Creating a generalized script for use in controlling use of a network resource**

Claim 8 is amended to recite, *inter alia*, the features,

capturing one or more request and response communications between a client and a server during a session of navigating the network resource;
storing in electronic memory meta-information that represents the one or more request and response communications;
automatically creating and storing an access and navigation script based on the meta-information, wherein the access and navigation script represents navigation actions performed during the session of navigating and includes a request to a server;
modifying the access and navigation script to result in creating and storing a generalized script that, upon playback, can accept context specific request information at a predefined location in the generalized script, for association with the request to the server.

Anuff does not teach, suggest or motivate any of the following features of Claim 8: (1) capturing response and request communications between a client and server during a session of navigating the network resource; (2) storing in electronic memory meta-information that represents the one or more request and response communications; (3) automatically creating an access and navigation script based on the meta-information, where the script includes a request to a server and represents navigation actions performed during the session; and (4) creating a generalized script by modifying the access and navigation script so that, upon playback, the generalized script can accept context specific request information at a predefined location in the generalized script, for association with the request to the server.

Because *Anuff* does not fairly teach or suggest these features of Claim 8, *Anuff* does not support a prima facie obviousness rejection of Claim 8. Because *Smith* does not cure these deficiencies of *Anuff*, Claim 8 is patentable over *Smith* in view of *Anuff*.

(II) **Using the generalized script to control use of the network resource**

Claim 8 further recites use of the generalized script, by merging contemporaneous information that is specific to a client request for use of the network resource into the generalized script at the predefined location, to create a context-specific version of the request to the server. Hence, the user of the generalized script can navigate the network resource only as set forth in the generalized script. Consequently, the user's access to and use of the network resource are controlled in a pre-determined way, based upon the prior navigation of the network resource from which the access and navigation script was created.

Not only do *Smith* and *Anuff* fail to fairly teach or suggest that a generalized script is created as recited in Claim 8, neither of these references teach or suggest controlling use of a network resource in response to a user request, through use of such a generalized script. *Anuff* does not teach or suggest controlling a user's navigation through or within a network resource(s) in a pre-determined way based on a prior navigation session, as described in Claim 8. For this additional reason, Claim 8 is patentable over *Smith* in view of *Anuff*.

Independent Claims 16 and 20 recite similar features as Claim 8, rather in the context of an apparatus and a computer-readable medium, respectively. Claim 16 also recites architecture, which includes navigation capture and user view servers coupled to a data store. Thus, the distinctions between the cited references and Claim 8 described herein in reference to Claim 8, are also applicable to Claims 16 and 20. Therefore, Claims 16 and 20 are patentable over *Smith* in view of *Anuff*.

(III) **There is no motivation to combine the cited references**

In addition to a teaching of each and every feature of a claim, another criteria that must be met to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP § 2143 Basic Requirements of a Prima Facie Case of Obviousness.*

Moreover, the Court of Appeals for the Federal Circuit has stated that the best defense against hindsight-based obviousness is the requirement for a showing of a teaching or motivation to combine prior art references. In particular, the Federal Circuit has made clear that “a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential evidentiary component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125, 56 USPQ2d 1456 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225 [Fed. Cir. 1998]). Specifically, the showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are insufficient. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614 (Fed. Cir. 1999).

One skilled in the art at the time of the invention would not have been motivated to combine the teachings of *Smith* and *Anuff* to achieve what is recited in Claim 8 because, as discussed, these references do not teach or suggest creation of a generalized script from an access and navigation script that is based on requests and response communications during a navigation session. Furthermore, one skilled in the art at the time of the invention would not be motivated by the cited references to create such a generalized script for controlling use of a network resource because the output of the *Smith* and *Anuff* techniques are, respectively, composite data and a customizable user interface.

The Federal Circuit has reiterated that “the tests of whether to combine references need to be applied rigorously.” *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Broad, conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence” (*McElmurray v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993)), and a general relationship between fields of the prior art references is insufficient to suggest the motivation to combine such references (*In re Dembiczak*, 175 F.3d 994, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999)).

Guided by the foregoing principles, the Office Action statement that it would have been obvious to one of ordinary skill in the art to combine the teachings of *Smith* and *Anuff* because “*Anuff*’s teaching would allow to control the access of resources in a more efficient manner” does not meet the standard for an obviousness rejection under 35 U.S.C. § 103(a). The goals of efficiency are so general and vague that they cannot rationalize the specific invention that is claimed. With that in mind, it appears that impermissible hindsight was used to generate the foregoing statement of motivation.

Furthermore, “[t]hat one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.” *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Based on the foregoing, the cited references supply no such impetus to make the claimed invention. No probative evidence of obviousness has been identified, beyond the mere assertion that the claimed invention would be obvious based on the cited references.

One skilled in the relevant art would not likely refer to *Smith* to solve the problems that embodiments of the present invention solve, because it does not provide any relevant teachings

with respect to controlling use of a network resource. *Smith* is directed to producing and accessing composite data, as plainly stated in the Title and the Abstract. The present claims have no relation to composite data. Furthermore, the embodiments described throughout *Smith* are clearly directed to composite medical data (see, e.g., FIG. 2, FIG. 3, and related detailed description of *Smith*). For these reasons, it is highly unlikely that one skilled in the art who is trying to develop techniques for controlling a user's use of a network resource would even find *Smith* when searching relevant teachings.

In *In re Lee*, 61 USPQ2d 1430, 1434 (2002), the Court of Appeals for the Federal Circuit (CAFC) held that an examiner's conclusory statements did not adequately address the issue of motivation to combine. In vacating a rejection under 35 U.S.C. §103, the CAFC held that the examiner did not adequately support the selection and combination of the references. The CAFC explained:

The examiner's conclusory statements ... do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. (underline added)

In the present case, the Office Action similarly failed to adequately address the issue of motivation to combine the references. In the present case, the Examiner attempts to establish a motivation to combine *Smith* with *Anuff* based on the conclusory statement that the combination would "allow to control access of resources in a more efficient manner." This conclusory statement is based on subjective belief, and the authority on which this belief is founded is completely unknown.

The motivation to combine presented in the present case is neither clear nor particular, and can only be characterized as being both broad and conclusory. Consequently, the burden in making out a *prima facie* case of obviousness has not been met in the present case. Accordingly, one of ordinary skill in the art would not have been motivated to combine *Smith* with *Anuff*.

INDEPENDENT CLAIM 11

Independent Claim 11 recites similar features as Claim 8, rather in the context of a Web site as the network resource. Thus, the distinctions between the cited references and Claim 8 described herein in reference to Claim 8, are also applicable to Claim 11. Therefore, Claim 11 is patentable over *Smith* in view of *Anuff*.

DEPENDENT CLAIMS 9, 10, 17, 18, 21, 22, 24, 25

Dependent Claims 9, 10, 17, 18, 21, 22, 24, 25 depend, directly or indirectly, from one of independent Claims 8, 16 or 20. Because each of these dependent claims inherits all of the features of the parent claim from which it depends, these dependent claims are patentable over *Smith* in view of *Anuff* for at least the same reasons as their respective parent claims.

Additionally, each of claims 9, 10, 17, 18, 21, 22, 24, 25 contain features that make each of these claims separately patentable. For example, the citation of *Anuff* that the Office Action relied upon for an alleged teaching of Claim 21 merely refers to a predetermined layout of modules (i.e., windows) in a front page (i.e., a portal page). *Anuff* does not teach or suggest controlling a user's navigation through or within a network resource(s) in a pre-determined way based on a prior navigation session.

In view of the differences discussed herein in reference to the independent claims, no further discussion is presented in reference to Claims 9, 10, 17, 18, 22, 24, 25 at this time.

NEW CLAIMS 27-30

New Claims 27-30 depend from respective pending independent claims, and recite embodiments that include a feature that is described in the specification, for example, at page 11, lines 6-13. Thus, no new matter is introduced into the application through these new claims.

The feature recited in Claims 27-30 is “wherein the step of merging contemporaneous information includes overwriting a portion of the contemporaneous information with predefined information.” This feature further elaborates on how the use of a network resource is controlled via the generalized script. Through this feature, if a user attempts to input information into the generalized script, which is not allowed, the script will overwrite the user’s attempt and thereby control the user’s use of the resource. As such, the user is constrained to navigating the resource only as allowed by and encapsulated in the generalized script.

Neither *Smith* or *Anuff* teach or suggest an overwrite feature as recited in Claims 27-30. Hence, Claims 27-30 are patentable over *Smith* in view of *Anuff*.

CONCLUSION


For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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On 1/18/05 By 
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